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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,812	11/10/1999	MARK E. PENNELL	003824.P001	8501

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EXAMINER

NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 07/16/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/437,812

Applicant(s)

PENNELL ET AL.

Examiner

Quang N. Nguyen

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-83 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

1. This Office action is in response to the Application No. 09/437812 filed on 11/10/1999, the Notice to File Missing Parts filed on 12/14/1999, the Declaration and Surcharge Fee filed on 03/20/2000, and the Pre-Amendment and Power of Attorney filed on 05/25/2001.

Drawings

2. The drawings filed on 11/10/1999 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review", PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 46-48, 61-63, 73-75, and 80-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 46, 61, 73, and 80 recite "the pop-up screen" which lacks an antecedent basis.

Claims 74 and 81 recite "the causing message window" which lacks an antecedent basis.

Claims 47, 48, 62, 63, 75, and 82 are rejected because they are dependent claims on claims 46, 61, 73, 74, 80, and 81.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 9-19, 24-45, 49-60, 64-72, 76-79, and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woltz et al. (US 5,995,597), herein after referred as Woltz, in view of Bosco (US 6,335,963), and further in view of Durham et al. (US 5,832,502), herein after referred as Durham.

Referring to claims 1-4 and 9-16, Woltz discloses a system and method comprising: receiving emails from multiple web sites at an email control center; and forwarding one or more of the emails to a user's email account in accordance with instructions provided by the user to the email control center (see Woltz, C3: L18-67, C4: L1-44, and C5: L45-57). However, Woltz is silent on generating a unique email address when registering with each of multiple web sites; and identifying and sorting the emails according to the web sites from which the emails were received. In the related art, Bosco teaches an electronic mail system providing a user with

notification of a received email message without requiring the user to call into their email service provider which issues/generates a unique ID, password, account number, and email address for the user (see Bosco, C3: L33-54, C4: 52-67, and C5: 1-37). Also, Durham teaches a technique for generating a unique record index for sorting email messages in an electronic mail messaging system (see Durham, C4: L51-67, C5, and C6: L1-34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system and method of Woltz, Bosco, and Durham so as to have included all the limitations as claimed in claim 1 since such methods/techniques were conventionally employed in the electronic mail messaging system for providing notification of received email message to the recipient of the messages.

Referring to claims 17-19, 24-45, 49-60, 64-72, 76-79, and 83 the system, method, and computer readable storage medium of claims 17-19, 24-45, 49-60, 64-72, 76-79, and 83 are similar to the system and method of claims 2-4 and 9-16 in their limitations. Thus, the system of claims 17-19, 24-45, 49-60, 64-72, 76-79, and 83 are considered for the reasons stated in the discussions of claims 2-4 and 9-16.

6. Claim 5-8 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woltz, Bosco, and Durham as applied to claim 2 and 17 above, in view of Ouchi (US 5,978,836), and further in view of Waskiewicz (US 5,822,526).

Referring to claims 5-8, Woltz, Bosco and Durham disclose a system and method as in claim 2 above, but are silent on the generating of unique email address comprises adding one or more alphanumeric characters from a string concatenated as a prefix to a predetermined email

address portion which is a high level domain name identifying a central network site. In the related art, Ouchi teaches a system and method of generating a unique DOC value by concatenating the user email address and the time in milliseconds and date (see Ouchi, C8: L13-31). Also, Waskiewicz teaches a system and method of associating a user's mailbox address with its multiple proxy addresses (see FIG. 3, C2: L12-67, C3: L1-20, C5: L23-67, and C6: L1-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Woltz, Bosco, Durham, and Ouchi so as to add one or more alphanumeric characters with a predetermined email address portion to generate a unique email address since such methods/techniques were conventionally employed in the generating/creating an account for an Internet registration process.

Referring to claims 20-23, the system of claims 20-23 is similar to the method of claims 5-8 in their limitations. Thus, the system of claims 20-23 is considered for the reasons stated in the discussions of claims 5-8.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to maintaining, processing, and administering electronic mail system in general:

U.S. Pat. No. 5,923,845 to Kamiya et al.

U.S. Pat. No. 6,014,711 to Brown.

U.S. Pat. No. 6,052,709 to Paul.

U.S. Pat. No. 6,067,561 to Dillon.

U.S. Pat. No. 6,108,691 to Lee et al.

U.S. Pat. No. 6,122,632 to Botts et al.

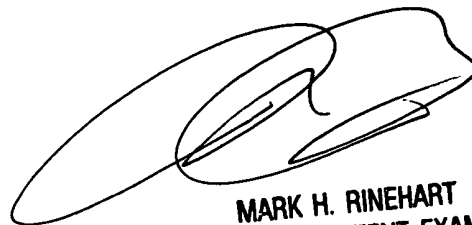
U.S. Pat. No. 6,138,146 to Moon et al.

8. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H. Rinehart can be reached on (703) 305-4815. The fax phone numbers for the organization is (703) 746-5485.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



**MARK H. RINEHART
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**

Qn
July 1, 2002